

### **REMARKS/ARGUMENTS**

Prior to entry of this Amendment, claims 1-15 and 19-21 were pending in this application. No claims have been amended, no claims have been added and no claims have been canceled herein. Therefore, claims 1-15 and 19-21 remain pending in this application. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

#### **35 U.S.C. § 112 Rejections**

The Office Action has rejected claims 1, 9 and 19 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The applicants respectfully traverse and request withdrawal of the rejection for at least the following reasons.

Regarding claim 1, the Office Action cites the claim element of "recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires" as not being described. The Applicants respectfully argue that the detailed description of the pending application does in fact provide an enabling disclosure of this claimed subject matter. Among possible other locations, this element is described in the detailed description of the Application on page 30, lines 11-29 describing recording initial segments of programs until a next NVD cycle begins at which point initial segments of a second set of programs is recorded. See specifically, page 30, lines 11-16. However, if a user selection is detected, only the selected channel is recorded. Page 30, lines 25-29. Therefore, a second segment of a second plurality of programs is recorded if the user request is not detected before the stagger period expires, i.e., before the end of the NVD cycle. See also page 31, line 17 - page 32, line 15 and Fig. 20A describing and illustrating storing portions of programs equal to the stagger time and storing portions of another program prior to the selection point, i.e., recording a second segment of a second plurality of programs if the user request is not detected before the stagger period expires.

Regarding claim 9, the Office Action cites the claim element of "determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored" as not being described. The Applicants respectfully argue that the detailed description of the pending application does in fact provide an enabling disclosure of this claimed subject matter. Among possible other locations, this element is described in the detailed description of the Application on page 31, line 17 - page 32, line 20 and illustrated in Fig. 20A. More specifically, page 31, lines 28-31 describe determining whether a segment is already stored and storing only segments that are not already stored.

Regarding claim 19, the Office Action cites as not being described the claim element reciting "discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program." The Applicants respectfully argue that the detailed description of the pending application does in fact provide an enabling disclosure of this claimed subject matter. Among possible other locations, this element is described in the detailed description of the Application on page 19, line 17 - page 20, line 24 describing saving an initial segment equal to the stagger time between program start times (i.e., less than the duration of the program) prior to a user selection, page 17, lines 8-20 describing ways in which a user may request or select content, and page 30, line 5 - page 34, line 15 describing discontinuing the recording of a first segment (i.e., the unselected channels) when the channel is not selected by the end of the first segment. More specifically the selected channel and only the selected channel is recorded beyond the first segment. See page 30, lines 26-27. Therefore, recording of the channels that are not selected is discontinued.

For at least these reasons, the applicants respectfully contend that the rejection of claims 1, 9, and 19 is improper and should be withdrawn.

**35 U.S.C. § 103 Rejection, Inoue**

The Office Action has rejected claims 1-15 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. (hereinafter “Inoue”). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP § 706.02(j). However, as will be discussed below, the reference cited by the Office Action does not teach or suggest each claimed limitation.

Inoue “relates to a video signal receiver for a near video-on-demand broadcast system.” (Column 1, lines 7-8. ) In one embodiment of Inoue, “the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus.” (Column 8, lines 35-38.) “When a user requests reception and display of the video program, the pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program.” (Column 8, lines 38-42.) “Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed.” (Column 8, lines 42-44.)

Claim 1, upon which claims 2-8 depend, recites in part “recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs; detecting the user request for one of the first plurality of programs; recording at least a second segment of each of a second plurality of

programs sent from the content provider if the user request is not detected before a stagger period expires; and recording the one of the first plurality of programs if the user request is detected before the stagger period expires.” However, Inoue does not teach or suggest recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires. Rather, Inoue only records subsequent segments of a program if the program is selected by the user. (Column 8, lines 35-46, and column 8, line 63, through column 9, line 22.) For at least these reasons, the rejection should be withdrawn and claims 1-8 should be allowed.

Claim 9, upon which claims 10-15 depend, recites in part “determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored.” However, Inoue does not teach or suggest determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored. Rather, the methods for determining whether to pre-store a segment disclosed by Inoue include initiating recording based on a pre-determined time or based on a user selection of a program. (Column 8, lines 47-57.) However, nothing in Inoue teaches or suggests determining if any of a first segment of each of a plurality of programs are not already stored. For at least these reasons, the rejection should be withdrawn and claims 9-15 should be allowed.

Claim 19, upon which claims 20 and 21 depend, recites in part “recording a second segment of the program if the user request is detected before a period expires; and discontinuing the recording of the first segment if the user request is not detected before the period expires, wherein the period is less than a duration of the program.” However, Inoue does not teach or suggest discontinuing the recording of the first segment if the user request is not detected before the period expires. Rather, Inoue records the entire first segment, regardless of any time limits for user selection. For at least these reasons, the rejection should be withdrawn and claims 19-21 should be allowed.

### CONCLUSION

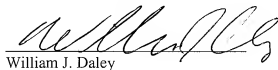
In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: \_\_\_\_\_

9/27/06



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